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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

EDMONDSON, LYNNE RENEE

ART UNIT

PAPER NUMBER

1725

DATE MAILED: 11/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|--------------|--|
| Application No. | Applicant(s) | |
| 09/977,855 | YOKOO, BUNGO | |
| Examiner | Art Unit | |
| Lynne Edmondson | 1725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 September 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 44-72 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 44-52,56-59 and 63-72 is/are rejected.

7) Claim(s) 53-55 and 60-62 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 13 November 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Double Patenting

1. Claims 44-52, 57-59 and 63-72 of this application conflict with claims 1-7, 12-15, 17-19, 22-24, 27, 28 and 32-40 of Application No. 09/842992. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 70-72 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 38-40 of copending Application No. 09/842992. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 44-52, 57-59 and 63-68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12-15, 17-19, 22-24, 27, 28 and 32-37 of copending Application No. 09/842992. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim soldering irons with releasably connected handles and methods of replacing them. In both cases, the soldering irons comprise sleeves having proximal ends and distal ends wherein the proximal end couples to a connector and the distal end connects to a tip. Both comprise insulators positioned between the sleeve and handle, contact fingers, heating elements, multiple layers, carbon and cylindrical cross sections. However, the instant claims use slightly different language. Where the instant claims teach that the handle opening is "adapted to receive the sleeve at a predetermined position...along the axis of the sleeve", the '992 claims teach the handle opening extends "axially therethrough being dimensioned to fit over a portion of the sleeve".

It would have been obvious to one of ordinary skill in the art at the time of the invention that the "predetermined position" of the instant claims is the same as the "portion" in the '992 claims. In both cases, the handle has an opening into which a segment of the sleeve is placed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 44, 45, 47, 48, 51, 57-59, 70 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosslow et al. (USPN 5524809).

Kosslow teaches a method of assembling a cartridge type soldering iron assembly comprising inserting a sleeve (110) through an opening in a handle (180). The sleeve is inserted through a hole in the handle (180) and coupled to an electrical connector (170). Coupling to the cartridge (130) is accomplished by contact fingers (160) (col 2 line 50 – col 3 line 6 and figure 2a). The heating elements (220, 230) are located within the sleeve (figure 3). The sleeve has a circular cross section. As shown

in figure 5, the sleeve does not completely contact the interior of the handle and forms an air passage. The sleeve comprises a ring (washer) at a predetermined position which acts as a stopper for the handle during relative movement between the handle and sleeve (col 3 lines 19-40).

7. Claims 44, 46, 51, 56, 57, 63-66 and 70-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Oki (JPN 53-118254)

Oki teaches a method of assembling a cartridge type soldering iron assembly comprising inserting a sleeve (4) through an opening in a releasably attached handle (6). The sleeve has a proximal end adapted to be coupled to a connector (7) and a distal end adapted to couple to a tip (2). An insulating sheath is placed between the sleeve and handle. A heating means is disposed within the sleeve. The handle is releasably located between the distal and proximal ends of the sleeve. There is no first handle to remove. See abstract and figures 1-6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 45, 58, 59 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki (JPN 53-118254).

Oki teaches a method of assembling a cartridge type soldering iron assembly comprising inserting a sleeve (4) through an opening in a releasably attached handle (6). The sleeve has a proximal end adapted to be coupled to a connector (7) and a distal end adapted to couple to a tip (2). An insulating sheath is placed between the sleeve and handle. A heating means is disposed within the sleeve. The handle is releasably located between the distal and proximal ends of the sleeve. There is no first handle to remove. See abstract and figures 1-6. As shown in the drawings, the handle and sleeve fit firmly. However, there is no disclosure of a ring around the insulator at a distance from the electrical contact or of replacing the handle for a better fit.

It would have been obvious to place a ring around the insulator as a stop for the handle to prevent the handle from going over the top of the proximal end and damaging the connector (7). As the handle is detachable, it can be removed for any reason including but not limited to replacement for repairs or replacement to attach a different size or type of handle.

Response to Arguments

9. Applicant's arguments with respect to claims 1-43 have been considered but are moot in view of the new ground(s) of rejection. It is noted that claims 1-43 have been canceled.

However, regarding applicant's argument that Kosslow does not teach handle between the proximal and distal end of a sleeve, see figures 2a, 2b and 4 where handle

180 is shown with an opening into which sleeve 110 is placed such that the handle is between both ends of 110.

Allowable Subject Matter

10. Claims 53-55 and 60-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Although it is known in the art to employ contact fingers and multilayered handles which may comprise graphite, there is no disclosure of such a handle disposed between the ends of a sleeve/tube. Such handles are typically attached at one end or the other. See Lichtenstien (DE 3929585 A1) and Cowell (USPN 5329085). Neither is an acute connector angle disclosed. Vella (USPN 4773582) teaches various angled connectors but none of the angles are defined.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kurpiela et al. (USPN 6215104 B1, temp sensor, fingers) and Claghorn et al. (USPN 4700031, replaceable handle).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (703)

306-5699. The examiner can normally be reached on M-F from 7-4 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7118 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Lynne Edmondson
Examiner
Art Unit 1725

LRE
November 24, 2002



11/29/02